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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/936,039      | 09/08/2001  | Georg Michael Ickinger | X-1139              | 7923             |

7590 06/24/2004

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EXAMINER

KASTLER, SCOTT R

ART UNIT PAPER NUMBER

1742

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

|                              |                        |  |                         |  |
|------------------------------|------------------------|--|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b>     |  |
|                              | 09/936,039             |  | ICKINGER, GEORG MICHAEL |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>         |  |
|                              | Scott Kastler          |  | 1742                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-90 is/are pending in the application.
- 4a) Of the above claim(s) 45-75 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-87 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 88-90 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/17/02 11/12/02</u>  | 6) <input type="checkbox"/> Other: _____                                    |

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***Election/Restrictions***

Applicant's election of claims 76-90 in the reply filed on 4-20-2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 45-75 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4-20-2004.

***Specification***

The substitute specification, submitted in the pre-amendment filed on 9-8-2001 has been entered.

***Means-Plus-Function Language***

Instant claims 76 and 77 contain the following terms written in means-plus-function format, and have been interpreted as follows:

1. "means for introducing a viscous medium into said conduit inlet" (claim 76) is in proper mean-plus-function format and is defined in the specification at page 19, lines 1-5 and figure 3 for example.
2. "valve means for controlling fluid communication of said bore with said inlet" (claim 76) is in proper mean-plus-function format and is defined in the specification at figure 1 (the "VCO" nozzle tip) for example.

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3. "actuating means for axially moving said needle" (claim 76) is in proper mean-plus-function format and is defined in the specification at page 15, lines 5-11 for example.

4. "mixing means" (claim 77) is in proper mean-plus-function format, but is not specifically described in the specification, so this term has been interpreted to mean any means allowing for the mixing of the medium with the additive.

### ***Claim Objections***

Claims 88-90 are objected to because of the following informalities: The above claims are informal because the use of the term "the group comprising" improperly renders the following Markush groups open. This term should be replaced by the term "the group consisting of". See MPEP 2173.05 (h) I. Appropriate correction is required.

### ***Allowable Subject Matter***

Claims 76-87 are allowed. The above claims are allowable over the cited prior art at least because none of the cited prior art shows or fairly suggests the use of the instantly recited combination of pressure regulator and actuating means in dispensing an additive into a viscous medium in a pulsing manner which, as stated in the specification at page 3 lines 15-30 for example, allows for more exact dosing and homogenous mixing of the additive with the medium.

Claims 88-90 would also be allowable over the cited prior art at least for the reasons given above should the objections to these claims be obviated.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of Goudeaux et al and Rogers are also cited as further examples of prior art injection devices.

This application is in condition for allowance except for the following formal matters:

The objections to the claims recited above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

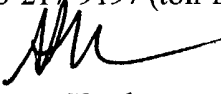
A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Kastler  
Primary Examiner  
Art Unit 1742

sk